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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/591,577	06/09/2000	Charles A. Eldering	T702-03	2970
27832	7590	10/20/2003	EXAMINER	
EXPANSE NETWORKS, INC. 6206 KELLERS CHURCH ROAD PIPERSVILLE, PA 18947			GRAVINI, STEPHEN MICHAEL	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 10/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

<b>Application No.</b> 09/591,577	<b>Applicant(s)</b> ELDERING ET AL.
<b>Examiner</b> Stephen M Gravini	<b>Art Unit</b> 3622

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) Responsive to communication(s) filed on 24 September 2003.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) Claim(s) 76-121 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 76-121 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - a)  The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ .
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .	6) <input type="checkbox"/> Other: _____ .

## DETAILED ACTION

### **Claim Rejections - 35 USC § 101**

Claims 76-114 are rejected under 35 U.S.C. 101 because the claimed method of consumer advertising does not recite a useful, concrete and tangible result under In re Alappat, 31 USPQ2d 1545 (Fed. Cir. 1994) and State Street Bank & Trust Co. v. Signature Financial Group Inc., 47 USPQ2d 1596 (Fed Cir. 1998). The independently claimed invention contain recitations of descriptive material that cannot exhibit any functional interrelationship with the way in which computing process are performed and does not constitute a statutory process, machine, manufacture or composition of matter under 35 USC 101. The independently claimed steps are claimed as merely data and information gathering and processing steps which do not involve manipulation of that data with a structural element. Because the independently claimed invention is directed to non-functional descriptive material which does not produce a useful, concrete and tangible result, those claims and claims depending from them, are not permitted under 35 USC 101 because the invention is considered non-statutory subject matter.

### ***Allowable Subject Matter***

Claims 115-121 are allowed while claims 76-114 are allowable over the prior art. The following is an examiner's statement of reasons for allowance for the claims over the prior art: the claimed invention including either feature of an advertisement discretionary element retrieval which includes a selection of target market characteristics not typically associated with any one of an advertised item, target market characteristics with heuristic rules, and not directly identifiable from consumer transactions or a linear

operation on a subset of consumers to generate targeting information. The feature of advertisement discretionary element retrieval which includes a selection of target market characteristics not typically associated with any one of target market characteristics with heuristic rules, not directly identifiable from consumer transaction records, and target market characteristics not typically associated with an item being advertised an advertised item, target market characteristics with heuristic rules is found in each of the independent claims 76 (target market characteristics with heuristic rules), 86 (not directly identifiable from consumer transaction records), and 92 (target market characteristics not typically associated with an item being advertised) respectively. While the feature linear operation on a subset of consumers to generate targeting information is found in each of independent claims 110 and 115. The closest prior art is applicants' patent US 6,216,129 rejected by the examiner while the most relevant foreign reference and not patent literature is considered WO 98/34189 and US 2003/0004810 none of which expressly or implicitly teach the independently claimed advertisement discretionary element retrieval or linear operation.

### ***Response to Amendment***

The rejection above is considered proper since the amendment occurs in the preamble of the independently claimed invention. The preamble is not considered to patentably distinguish the invention, since it does not breath life and meaning into the claim. If the processing means such that structural interaction or mechanical intervention occurs

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in the body of the claim, then the non-statutory subject matter rejection would be overcome.

***Conclusion***

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Steve Gravini whose telephone number is (703) 308-7570 and electronic transmission / e-mail address is "steve.gravini@uspto.gov". Examiner can normally be contacted Monday through Friday from 6:00 a.m. to 3:30 p.m. If applicants choose to send information by e-mail, please be aware that confidentiality of the electronically transmitted message cannot be assured. Please see MPEP 502.02. Information may be sent to the Office by facsimile transmission. The Official Fax Numbers for TC-3600 are:

After-final	(703) 872-9327
Official	(703) 872-9306
Non-Official/Draft	(703) 872-9325

*Steve Gravini*  
STEPHEN GRAVINI  
PRIMARY EXAMINER

smg

October 15, 2003